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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,516	05/31/2000	David A. Grabelsky	00,011	1984
7590 03/01/2004			EXAMINER	
McDONNELL BOEHNEN HULBERT & BERGHOFF			HOM, SHICK C	
300 South Wacker Drive Chicago, IL 60606			ART UNIT	PAPER NUMBER
			2666	
		DATE MAILED: 03/01/2004		

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
•	09/584,516	GRABELSKY ET AL.				
Office Action Summary	Examiner	Art Unit				
	Shick C Hom	2666				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPL' THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.1 after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period of Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be t y within the statutory minimum of thirty (30) da will apply and will expire SIX (6) MONTHS fron , cause the application to become ABANDON	imely filed ays will be considered timely. m the mailing date of this communication. ED (35 U.S.C. § 133).				
Status						
1)⊠ Responsive to communication(s) filed on <u>31 M</u>	lay 200 <u>0</u> .					
,	action is non-final.					
	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
Disposition of Claims						
4)	wn from consideration. rejected. 33 is/are objected to.					
Application Papers		•				
9)☐ The specification is objected to by the Examine	r.					
10)☐ The drawing(s) filed on is/are: a)☐ acc	The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.					
Applicant may not request that any objection to the		* *				
Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Ex	* * * * * * * * * * * * * * * * * * * *					
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority document: 2. Certified copies of the priority document: 3. Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list	s have been received. s have been received in Applica rity documents have been receiv u (PCT Rule 17.2(a)).	tion No ved in this National Stage				
Attachment(s)	_					
 Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-948) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3. 6. 	4) Interview Summar Paper No(s)/Mail I 5) Notice of Informal 6) Other:					

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DETAILED ACTION

Specification

- 1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
- 2. The disclosure is objected to because of the following informalities: in page 1 lines 5-6 update status of U.S.

 Application No. 09/035,600 as now being U.S. Patent no.

 6,353,614. In page 31 line 19 update status of U.S.

 Application No. 09/270,967 if known. In page 3 lines 8-10 which recite P. Srisureh, "IP Network Address Translator (NAT) Terminology and Considerations," Aug. 1999 and in page 28 lines 12-13 which recite Cuervo et al., "Megaco Protocol" being incorporated by reference is objected to because a copy of the references must be provided for proper consideration. Appropriate correction is required.

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Claim Objections

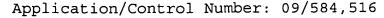
3. Claims 14-33 are objected to because of the following informalities: in claim 14 line 3 delete typo "clienton" and insert ---client on---. In claims 30 and 32 line 2 spell-out acronym MEGACO, i.e. delete ---MEGACO--- and insert ---Media Gateway Control MEGACO---, for clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. Claims 5 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears that claims 12 and 5 are the same and therefore is not clear as to what further limitation is recited in claim 12 that is not already claimed in claim 5.

5. Claims 14, 16, and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,353,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claim 14 merely broaden the



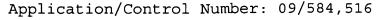
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scope of U.S. Patent No. 6,353,614 claims 4 and 9 by eliminating the method being of distributed network address translation. Application's dependent claim 16 corresponds to U.S. Patent No. 6,353,614 claim 11; and application's dependent claim 25 corresponds to U.S. Patent No. 6,353,614 claim 9. It has been held that the omission of a element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal



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disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 8. Claims 1-5, 9, 11-14, 16, 19, 23, 25, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Andrews et al. (5,835,723).

Regarding claim 1:

Andrews et al. disclose the method of implementing

Realm Specific Internet Protocol in a network access system

comprising a plurality of network sub-devices connected by

a network, the method comprising the steps of: (a)

requesting by a first network sub-device using a first

protocol a common external network address and one or more

ports from a second network sub-device to identify a first

network sub-device during communications with an external

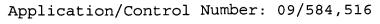
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computer network (see col. 3 lines 4-19 and col. 4 lines 18-25); (b) receiving the common external network address and an identifier of the one or more ports at the first network sub-device from the second network sub-device (see abstract and col. 1 line 64 to col. 2 line 29); (c) updating entries in an address-to-address table maintained by the second network device to reflect assignment of the common external network address and one or more ports to the first network sub-device (see col. 6 lines 45-52); and (d) creating a combination network address for the first network sub-device with the identifier of the one or more ports and the common external network address, the combination network address identifying the first network sub-device for communications with the external computer network (see col. 3 lines 4-19, col. 4 lines 18-25, and col. 8 lines 7-27).

Regarding claim 2:

Andrews et al. disclose the computer readable medium having stored therein instructions for causing a central processing unit to execute the method of claim 1 (see col. 1 line 64 to col. 2 line 29).

Regarding claim 3:



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Andrews et al. disclose the method of claim 1 further comprising (a) sending a request from the first network sub-device to the second network sub-device; (b) routing the request from the second network subdevice to the external computer network (see col. 3 lines 4-19 and col. 4 lines 18-25); (c) receiving a reply at the second network subdevice on the common external network address for the network access system (col. 1 lines 64 to col. 2 line 29); and (d) routing the reply from the second network subdevice to the first network subdevice using the locally unique port from the combination network address (see col. 3 lines 4-19).

Regarding claim 4:

Andrews et al. disclose wherein the first protocol is a Realm Specific Internet Protocol comprising a Realm Specific Internet Protocol assign request message, a Realm Specific Internet Protocol assign response message, and a combination network address involving a locally unique port and a common external network address (see col. 3 lines 4-19, col. 4 lines 18-25 and col. 8 lines 7-27).

Regarding claims 5 and 12:

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Andrews et al. disclose wherein the common external network address is an Internet protocol address (see col. 1 lines 41-53).

Regarding claim 9:

Andrews et al. disclose wherein the second network subdevice is a router or a port server (see col. 5 lines 41-55).

Regarding claim 11:

Andrews et al. disclose wherein the external computer network is any of the Internet, an intranet or a public-switched telephone network (col. 1 lines 41-53).

Regarding claim 13:

Andrews et al. disclose wherein the plurality of subdevices on the network access system comprise a local area network and the external network is any of the Internet or an intranet (col. 6 lines 24-44).

Regarding claim 14:

Andrews et al. disclose the network access device, comprising in combination: (a) a first network; (b) a first network subdevice comprising a network client on the first network (see col. 5 lines 41-55), wherein the first network subdevice has a first network address for communicating with other network subdevices and requests from a second

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network subdevice allocation of a second network address and one or more ports for communicating with a plurality of network devices on a second network (see col. 3 lines 4-19 and col. 4 lines 18-25); and (c) a second network subdevice on the first network comprising a network address server for allocating a second network address and one or more ports to the first network subdevice, wherein the second network subdevice has a first network address for communicating with other network subdevices on the first network and a second network address for communicating with a plurality of network devices on a second network, and wherein the network address server is used to allocate the second network address to the first network subdevice on the first network (see col. 3 lines 4-19, col. 4 lines 18-25, col. 8 lines 7-27, and col. 5 lines 41-55).

Regarding claim 16:

Andrews et al. disclose wherein the second network is a public network (in col. 1 lines 41-53 the Internet corresponds to the public network).

Regarding claim 19:

Andrews et al. disclose wherein the first network subdevice further comprises an IP interface and the client of the first network subdevice is a Realm Specific Internet

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Protocol host (see col. 1 lines 41-53 and col. 5 lines 41-55).

Regarding claim 23:

Andrews et al. disclose wherein the first network subdevice further comprises a data application and a device control application (see col. 4 lines 8-25).

Regarding claim 25:

Andrews et al. disclose wherein the second network subdevice is a router subsystem (see col. 5 lines 41-55). Regarding claim 27:

Andrews et al. disclose wherein the second network is any of the Internet or an intranet (col. 1 lines 41-53).

Allowable Subject Matter

9. Claims 6-8, 10, 15, 17-18, 20-22, 24, 26, and 28-33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Borella et al. (6,353,891) disclose control channel security for Realm specific Internet protocol.

Lin et al. (6,282,575) disclose a routing mechanism for networks with separate upstream and downstream traffic.

11. Any response to this nonfinal action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (2600 Receptionist at (703) 305-4750).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick Hom whose telephone number is (703) 305-4742. The examiner's regular work schedule is Monday to Friday from

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

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February 24, 2004

reached at (703) 308-5463.